

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claim 20 has been objected to.

Claims 1, 6, 8, 9, 17, and 20 have been amended as shown above.

Claim 21 has been added.

Claims 1-21 are now pending in this application.

Reconsideration and full allowance of Claims 1-21 are respectfully requested.

I. OBJECTION TO THE CLAIMS

The Office Action objects to Claim 20 as being an improper dependent claim. In particular, the Office Action notes that Claim 20 (which recites a “shared bus system”) depends from Claim 19 (which recites a “method”). The Applicant has amended Claim 20 to recite a “method.” The Applicant respectfully requests withdrawal of the objection to the claims.

II. REJECTION UNDER 35 U.S.C. § 112

The Office Action rejects Claims 17 and 20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter regarded as the invention. In particular, the Office Action asserts that Claims 17 and 20 suffer from several antecedent basis problems. The Applicant has amended Claims 17 and 20 to correct the noted antecedent basis problems. The Applicant respectfully requests withdrawal of the § 112 rejection.

III. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-4, 7-12, and 15-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,163,850 to Wood et al. ("*Wood*"). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Wood recites a system that allows multiple cards containing clock sources coupled to a bus to control a backplane clock signal. (*Abstract*). Each card contains circuitry that allows that card to control the bus. (*Figures 3A-3C; Col. 2, Lines 48-52*). Each card decides whether to take control the bus using messages received by that card over a control channel. (*Col. 2, Lines 16-46*).

Claim 1 has been amended to recite an "input circuit" capable of receiving a "first bus access request signal" from a first bus device and a "second bus access request signal" from a second bus device. The input circuit is also capable of "outputting the second bus access request signal when the first bus access request signal is not enabled and blocking the second bus access request signal when the first bus access request signal is enabled."

Wood fails to recite any type of input circuit that blocks or does not block a bus access

request signal based on another bus access request signal. In fact, *Wood* contains absolutely no mention of any component that is capable of receiving multiple bus access request signals from multiple bus devices. As a result, *Wood* fails to anticipate all elements of Claim 1.

Claim 9 has been amended to recite a “bus keeper” capable of “holding each line of [a] shared bus at a particular logic level” when all “tristate line drivers are put into [a] high-impedance state.” Claim 17 has been amended to recite “holding each line of [a] shared bus at a particular logic level” when all “tristate line drivers are put into a high-impedance state.”

Wood fails to recite any type of component that is capable of holding lines of a bus at a particular logic level when none of the cards is controlling the bus. In fact, *Wood* fails to even identify a situation where all of the cards are prevented from controlling the bus. As a result, *Wood* fails to anticipate all elements of Claims 9 and 17.

For these reasons, *Wood* fails to anticipate the Applicant’s invention as recited in Claims 1, 9, and 17 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-4, 7-12, and 15-20.

IV. **REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejects Claims 5, 6, 13, and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Wood* in view of U.S. Patent No. 5,306,963 to Leak et al. (“*Leak*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260,

1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir. 1992*)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (*Fed. Cir. 1984*)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir. 1993*)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (*Fed. Cir. 1985*)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (*Fed. Cir. 1993*)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

As described above, *Wood* fails to disclose, teach or suggest various elements recited in Claims 1 and 9. *Leak* is not cited by the Office Action as disclosing, teaching, or suggesting these elements of Claims 1 and 9. As a result, the Office Action has not shown that the proposed *Wood-Leak* combination discloses, teaches, or suggests all elements of Claims 5, 6, 13, and 14 (which depend from Claims 1 and 9).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 5, 6, 13, and 14.

V. NEW CLAIM

The Applicant has added new Claim 21. The Applicant respectfully submits that no new matter has been added. The Applicant respectfully requests entry and full allowance of Claim 21.

VI. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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